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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/754,296 01/05/01 TAJIMA

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EXAMINER

NGUYEN, T

ART UNIT

PAPER NUMBER

2834

DATE MAILED:

04/24/01

MM91/0424
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/754,296

Applicant(s)
Tajima et al

Examiner
Nguyen, Tran

Group Art Unit
2834



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 18-24 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 18-24 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☒ received in Application No. (Series Code/Serial Number) 08/946,581.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *electromotive vehicle's drive device* must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Specification

2. The disclosure is objected to because of the following informalities: the specification should clarify that the present application is a continuation of a previously filed application and the information of the parent application, i.e., its serial number and the patent number.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 22-24 are rejected under 35 U.S.C. 112, first paragraph**, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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In claims 22-24 the recitation “an electromotive vehicle comprising a drive device” contains new subject matter. The specification, i.e., the detailed description of the invention and the drawings, does not specifically describe any electromotive vehicle comprising a drive device that includes the PM machine of the present invention in such a way as to reasonably convey to one skilled in the art that the instant invention’s spacer posts disposed in contact with facing surfaces of adjacent magnetic laminations. If the applicant believes that the examiner of the record has overlook the disclosure of this particular feature, then kindly point out the exact location, i.e., page and line numbers, in the specification that discussed about this feature.

5. **Claims 18-19** are rejected under *35 U.S.C. 112, second paragraph*, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 18-19, “the permanent magnet insertion holes arranged with a ring form” is indefinite because it is unclear. Should it be “the permanent magnet insertion holes arranged circumferentially in a ring-shaped arrangement” ?

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. **Claims 18-19** are rejected under 35 U.S.C. 102(e) as being anticipated by Brandes et al, (US 5672926).

Brandes et al (figs. 1-3) disclose a permanent magnet electric rotary machine comprising: a stator (2) having winding (3); a rotor (4) having a plurality of permanent magnets (9) being inserted in insertion holes (9), wherein the magnets are arranged so that at least one magnetic gap is provided between the permanent magnets and auxiliary magnetic poles (13). The rotor's magnetic pole piece portions (11) are connected to the auxiliary pole portions (13) by the magnetic saturation bridge portion (12).

Obviousness-type Double Patenting

8. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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9. **Claims 18-24** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claims 1-2, 4-11 and 13-15** of U.S. Patent **6208054** to Tajima et al in view of level of **Johnson** (US 5475277).

Regarding Claims 18-21, claims 1-2, 4-11 and 13-15 of US '054 are similar to claims 18-21 of this application. The only difference is that the claimed invention recites the permanent magnet insertion holes arranged with a ring form.

Johnson, however, teaches a plurality of permanent-magnet-insertion holes arranged in a configuration of a ring form (fig 1). Furthermore, a cylindrical rotor having magnets being arranged in a ring form is well known in the art.

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the US '054 machine by arranging the inserting holes for the magnets in a ring-form configuration, as taught by Johnson. Doing so would require only ordinary skill of a worker in the art because this configuration is a well-known arrangement for a cylindrical rotor of a permanent magnet electrical rotating machine.

Regarding claims 22-24 Johnson further teaches that a primary application of a permanent magnet electrical rotating (PMER) machine is in electric powered vehicles having a drive device. This is a well-known application of a PMER machine.

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed machine in an electromotive vehicle because it is a well-known application of PMER machines.

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See FTO Form 892 for cited references.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran Nguyen whose telephone number is (703) 308-1639.

12. Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1782. The fax phone number for this Group is (703) 305-3431 (32).

A handwritten signature in black ink, appearing to read 'Tran Nguyen', with a long horizontal flourish extending to the right.

TN

April 20, 2001

**Tran Nguyen
Patent Examiner
Technology Center 2800**